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09/915,425	07/26/2001	Jordan Pollack	**13-0006	6994
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CHAO, MICHAEL W				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/915,425

**Applicant(s)**

POLLACK, JORDAN

**Examiner**

Michael Chao

**Art Unit**

2442

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☒ Claim(s) 9, 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Objections***

Claim 9, of the 09/15/2008 submission is objected to because of the following informalities:

- Claim 9 contains the misspelled word "ales"; examiner interprets this to mean 'files'.

Appropriate correction is required.

Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The claim 15 limitation of "change the date of autodeletion of the file", presumes the existence of the deletion timer of claim 14.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how a software program could physically mail a paper document to a third party.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 17, 18-19, 25, are rejected under 35 U.S.C. 102(e) as being anticipated by Karim (U.S. 6,654,892).

With respect to claims 1, 18, 19, 25, Karim teaches; A system for management and manipulation of stored files through electronic mail items comprising:

a first receiving portal configured to receive, from a sender, a first electronic mail item addressed to a recipient, wherein the first electronic mail item comprises a file; ("control command is a "check in" command indicating that the source code in the associated identified file is being checked into the source code control system" Karim column 5 line 62)

a mail processor configured to produce a stripped electronic mail item by removing the file from the first electronic mail item and replacing it with a corresponding

file handle; ("the command is obtained from the client e-mail at block 706 and the associated file name is obtained at block 708" Karim column 8 line 57)

a storage device configured to store the file; (See Karim Figure 10, Ram, Primary Storage, Secondary Storage)

a mail deliverer configured to send the stripped electronic mail item to the recipient; ("where the client code control command is a check out command, the content of the file being checked out of the source code control system may be provided as an attachment file" Karim column 7 line 22)

a second receiving portal configured to receive, from the recipient a second electronic mail item including a first field which contains a user identification, ("if it is determined at block 504 that the password is invalid, the e-mail is ignored" Karim column 6 line 40) a second field which contains the file handle, and a third field which contains a command specification, without prompting for the email item; ("the command is obtained from the client e-mail at block 706 and the associated file name is obtained at block 708" Karim column 8 line 57)

a rights verifier configured to determine whether the recipient has privilege to access the stored file corresponding to said file handle; ("if it is determined at block 504 that the password is invalid, the e-mail is ignored" Karim column 6 line 40)

a file handle recognizer configured to locate a file handle pattern within the electronic mail item; and ("the command is obtained from the client e-mail at block 706 and the associated file name is obtained at block 708" Karim column 8 line 57)

1 a command executor configured to execute said command specification on the  
2 file retrieved from said storage device when the recipient is verified to have the access  
3 rights to the file. ("The execution engine may therefore identify the command data  
4 structure and retrieve any associated files" Karim column 9 line 30)

5 Regarding claim 2, Karim teaches; wherein the file handle recognizer is  
6 configured for locating conforming file handle patterns within the body of the electronic  
7 mail item. ("the command is obtained from the client e-mail at block 706 and the  
8 associated file name is obtained at block 708" Karim column 8 line 57)

9 Regarding claim 3, Karim teaches; further including a user identification system  
10 which extracts information from the electronic mail item including the from address,  
11 destination address, the subject, ("includes a mail header" Karim column 4 line 55) the  
12 reply-to, and the body of the electronic mail item, to enable verification of the sender as  
13 a known user of the system. (See Karim Figure 2)

14 Regarding claim 4, Karim teaches; further including a command parser which  
15 recognizes and assembles a command out of the information extracted from the  
16 electronic mail item. ("The execution engine may therefore identify the command data  
17 structure and retrieve any associated files" Karim column 9 line 30)

18 Regarding claim 6, Karim teaches; wherein the command specification instructs  
19 said command executor to retrieve the file as an email attachment. ("where the client  
20 code control command is a check out command, the content of the file being checked  
21 out of the source code control system may be provided as an attachment file" Karim  
22 column 7 line 22)

Regarding claim 17, Karim teaches; wherein the storage device is chosen from the group consisting of hard drives, optical drives, random access memories, tape drives, RAID arrays, and storage area networks. (hard disk, Karim column 11 line 44)

Regarding claims 20, 22, 23, Karim teaches a ROM, RAM, (Karim column 11 line 30) and a hard disk. (Karim column 11 line 44)

Regarding claims 26, 28, Karim teaches a general-purpose computer system. (column 11 line 24)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7, 9, 10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Karim, in view of Boaz et al. (U.S. 5,333,266).

Regarding claim 5, Karim does not explicitly teach; wherein the command specification instructs said command executor to delete the file from said storage device. Boaz teaches such a feature; "From the file option, a user can select Properties, Move, Discard, Send and Dial operations." (Boaz column 21 line 12). A person of ordinary skill would have used the file operations of Boaz with the invention of Karim by allowing further options to a user of the system of Karim. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to use the

1 features of Boaz with the invention of Karim in order to accommodate common file  
2 handling operations.

3       Regarding claim 7, Karim does not explicitly teach; wherein the command  
4 specification instructs said command executor to forward the file to a third party as an  
5 email attachment. Boaz teaches such a feature; "A mail item of any media type can also  
6 be forwarded" (Boaz column 21 line 26). A person of ordinary skill would have used the  
7 file operations of Boaz with the invention of Karim by allowing further options to a user  
8 of the system of Karim. It would have been obvious at the time the invention was made  
9 to a person of ordinary skill in the art to use the features of Boaz with the invention of  
10 Karim in order to accommodate common file handling operations.

11       Regarding claim 9, Karim does not teach; wherein the command specification  
12 instructs said command executor to print the file on a fax machine at a specified  
13 telephone number. Boaz teaches such a feature; "image or text document be faxed to a  
14 remote phone number for review" (Boaz column 214 line 45). A person of ordinary skill  
15 would have used the file operations of Boaz with the invention of Karim by allowing  
16 further options to a user of the system of Karim. It would have been obvious at the time  
17 the invention was made to a person of ordinary skill in the art to use the features of  
18 Boaz with the invention of Karim in order to allow "a request from a local terminal to  
19 access message functions from a foreign messaging system." (Boaz column 2 line 23)

20       Regarding claim 10, Karim does not explicitly teach; further including at least one  
21 of an optical character recognition device, automatic speech recognition device,  
22 language translation device, and a file format translation device associated with said



1 command executor. Boaz teaches such a feature; "Also in memory 100 are Text to  
2 Speech and Speech to Text Code Module 140, and Optical Character Recognition to  
3 Text . . ." (Boaz column 7 line 43). A person of ordinary skill in the art at the time of  
4 invention would have combined the conversion tools of Boaz with the invention of Karim  
5 by converting received attachments to required formats. It would have been obvious at  
6 the time the invention was made to a person of ordinary skill in the art to use the  
7 conversion tools of Boaz with Karim in order to allow a "document or a portion thereof  
8 [to] be reviewed" (Boaz column 24 line 30).

9 Claims 11, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
10 Karim, in view of Pearl et al. (US 2002/0083035).

11 Regarding claim 11, Karim does not explicitly disclose; wherein the command  
12 specification instructs said command executor to convert the file to plain text and email  
13 it back to the sender. Pearl discloses such a feature; "translates the content to a text  
14 format compatible for display on the wireless device" (Pearl paragraph [0006]). A person  
15 of ordinary skill in the art would have used the conversion method of Perl with Karim by  
16 converting the file to a format usable by the receiving device. It would have been  
17 obvious at the time the invention was made to a person of ordinary skill in the art to  
18 enable Karim to perform this conversion in order to allow a user to "view the text data on  
19 [a] wireless device from the delivered e-mail message" (Pearl paragraph [0006])

20 Regarding claim 16, Karim does not disclose; wherein said file handle is a  
21 uniform resource locator. Pearl discloses such a feature; "the present invention answers  
22 this need by providing a system and method for providing text data from Internet files

1 with an associated URL" (Pearl paragraph [0004]). A person of ordinary skill in the art at  
2 the time of the invention would have used URLs of Pearl with the invention of Karim by  
3 allocating structured handles of the form of a URL to sent files. It would have been  
4 obvious at the time the invention was made to a person of ordinary skill in the art to use  
5 the URLs of Pearl with Karim in order to allow for an intuitive delineation means for  
6 multiple files with common names.

7 Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karim in  
8 view of Boaz, in view of Tverskoy et al. (US 2001/0043678).

9 Regarding claim 12, Karim does not teach wherein the command specification  
10 instructs said command executor to convert the file to an audio file and to forward the  
11 audio file to a telephone at a specified number. Boaz discloses the conversion to an  
12 audio file with the reasoning listed in this office action in claim 10. Further, this  
13 combination does not explicitly disclose that the audio file is forwarded to a telephone  
14 number. This is taught by Tverskoy; "E-mail command messages may also be used to  
15 cause answering machine 12 to place a telephone call and play a recorded message."  
16 (Tverskoy paragraph [0038]). A person of ordinary skill in the art would have used the  
17 call feature of Tverskoy with the combination above by allowing a command to allow  
18 text documents to be dictated over a telephone line. It would have been obvious at the  
19 time the invention was made to a person of ordinary skill in the art to use the call feature  
20 of Tverskoy with the combination above in order to "document or a portion thereof [to]  
21 be reviewed" (Boaz column 24 line 30).

1 Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karim in  
2 view of Boaz, in view of Martin (US 6,432,232)

3 Regarding claim 13, Karim does not teach; wherein the command specification  
4 instructs the command executor to automatically print the file and mail it to a third party.  
5 Martin teaches said feature; "it is an object of the subject invention to provide an  
6 inexpensive system that can automatically generate finished letter mail, of several  
7 pages if desired, at lightly attended remote terminals, so long as the system is  
8 electronically connected to a computer, anywhere in the world when tied to the internet  
9 and E-mail" (Martin column 1 line 66). A person of ordinary skill in the art would have  
10 combined the invention of Martin with Karim by using a device like Martins in the system  
11 of Karim. It would have been obvious at the time the invention was made to a person of  
12 ordinary skill in the art to include such a device in order to allow for a sender "to be sure  
13 that the recipient gets a hard copy" of the mail. (Martin column 1 line 65).

14 Claims 14, 15, are rejected under 35 U.S.C. 103(a) as being unpatentable over  
15 Karim in view of Boaz, in view of Ryan et al.

16 Regarding claim 14, Karim does not explicitly disclose; wherein the storage  
17 device further includes an automatic deletion timer associated with at least one of the  
18 stored files. Ryan discusses such a deletion timer; "At Input Block 352, the user enters  
19 the delete-date" (Ryan column 32 line 60). A person of ordinary skill in the art would  
20 have used the input of Ryan with the system of Karim by allowing a user to set a date  
21 that the file should be discarded. It would have been obvious at the time the invention

1 was made to a person of ordinary skill in the art to use a delete date with Karim in order  
2 to free up space from unused files on the system.

3 Regarding claim 15, Karim does not explicitly disclose; wherein the command  
4 specification instructs the command executor to change the date of autodeletion of the  
5 file. Ryan discusses such a deletion timer; "At Input Block 352, the user enters the  
6 delete-date" (Ryan column 32 line 60). A person of ordinary skill in the art would have  
7 used the input of Ryan with the system of Karim by allowing a user to set a date that the  
8 file should be discarded. It would have been obvious at the time the invention was made  
9 to a person of ordinary skill in the art to use a delete date with Karim in order to free up  
10 space from unused files on the system.

11 Claims 8, 21, 24, 27, 29, are rejected under 35 U.S.C. 103(a) as being  
12 unpatentable over Karim.

13 Regarding claim 8, Karim does not explicitly disclose; wherein the command  
14 specification instructs said command executor to forward to a third party a newly  
15 constructed file handle to the file stored on said storage device. However, it would have  
16 been obvious for the system to provide a method for automatic sharing of filenames. A  
17 person of ordinary skill in the art would have done this by either including third persons  
18 in the confirmation emails or providing a separate notification system to alert third  
19 persons of file updates. It would have been obvious at the time the invention was made  
20 to a person of ordinary skill in the art to implement such a handle forwarding means in  
21 order to allow the sharing of programs and data among employees (Karim column 1 line  
22 22).

Regarding claims 21, 24, Karim does not explicitly disclose a optical drive, or a tape drive for a storage means. However, it is an obvious alternative to use an optical drive, or a tape drive to store data. A person of ordinary skill in the art would have used either of these storage means by selecting them for the mass storage means of the server of Karim. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to use an optical drive or a tape drive dependent upon the cost and efficiency requirements of the system install.

Regarding claims 27, 29, Karim does not explicitly disclose a programmable logic controller, or an array of network servers. However, it is an obvious alternative to use a PLC or an array of servers. A person of ordinary skill in the art would have used a PLC or an array of servers with the invention of Karim by installing the system software on either host machine. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to use a PLC or an array of servers dependent upon the capacity requirement of the system install.

### ***Response to Arguments***

Applicant's arguments, see pages 9-10, filed 09/15/2008, with respect to office action of 7/14/2008 have been fully considered and are persuasive. The email features of applicants invention were not disclosed by prior cited art. The rejection of claims 1-29 have been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Karim, Boaz, Pearl, Tverskoy, Martin and Ryan, as detailed above.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Keller et al. (U.S. 5,418,908) discloses email attachment references.
- Irribarren (U.S. 5,737,395) discloses voice, facsimile and email integration.
- Kuzma (U.S. 5,771,355) discloses email file references.
- Rachelson (U.S. 6,157,706) discloses a facsimile machine email client.
- Nakaoka (US 2001/0007992) discloses a transfer apparatus for email.
- Tomita (US 2001/0029541) discloses an equipment management system.
- Brilla et al. (US 6,389,276) discloses an SMS command system.
- Hasan (US 6,404,859) discloses a speech query.
- Hyde-Thomson et al. (US 6,487,533) discloses a language identification system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Chao whose telephone number is (571)270-5657. The examiner can normally be reached on 8-4 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. C./  
Examiner, Art Unit 2442

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